

**REMARKS/ARGUMENTS**

Reconsideration and allowance of this application are respectfully requested.

Currently, claims 1-13 are pending in this application.

**Rejection Under 35 U.S.C. §101:**

Claims 1-7 and 10 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

For the reasons expressed in Applicant's previous responses, Applicant disagrees with the final Office Action's allegation that claims 1-5 "is not directed to a statutory subject matter because the steps performed are not concretely and tangibly embodied and executed by a piece of hardware."<sup>1</sup> Nevertheless, claim 1 has been amended to recite "A computer-implemented method..." in accordance with the Examiner's helpful suggestions. In particular, the Advisory Action states "Moreover, there is no indication that the method is a computer-implemented method, which would thus direct the claim to statutory subject matter." Claim 1 now recites a computer-implemented method and is thus directed to statutory subject matter per the comments of the Advisory Action. Entry of this claim amendment is clearly in order since entry will at least simplify issues for appeal.

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<sup>1</sup> For the Examiner's information, attached hereto is a copy of the recently issued Precedential Opinion *Ex parte* Carl A. Lundgren (Appeal No. 2003-2088; Application No. 08/093,516). In this case, the Board held "[w]e find that the claim language recites subject matter that is a practical application of shifting of physical assets to the manager. We note the remaining claims also recite the above practical application. Therefore, we find statutory subject matter." (Pages 2-3 of the Decision). As can be appreciated from pages 1-2 of this Decision, the claimed subject matter does not explicitly recite a computer or automated means of any kind, yet was still found to be statutory. Accordingly, there is no requirement for steps to be concretely and tangibly embodied and executed by a piece of hardware for subject matter to be statutory as apparently alleged by the final Office Action and Advisory Action in the present application.

Similarly, claim 6 has been amended to recite “A computer-based apparatus...” which comprises a “computer-implemented means for the automatic registration. . .”, “computer-implemented means for associating. . .”, “computer-implemented means for selecting. . .”, and “computer-implemented means for comparing. . .” Accordingly, Applicant respectfully submits that claim 6 recites statutory subject matter. Entry of the amendments to claim 6 is in order since these amendments will at least simplify issues for appeal.

**Rejection Under 35 U.S.C. §102:**

Claims 1-13 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Hinckley (U.S. ‘869). Applicant respectfully traverses this rejection. Applicant has presented below the same arguments regarding Hinckley that were presented in Applicant’s previously-filed July 19, 2005 Response. Applicant notes that the Advisory Action mailed September 15, 2005 did not address these comments at all. If this rejection is maintained, Applicant respectfully requests that the next Office Action specifically address the comments provided below.

For a reference to anticipate a claim, each element must be found, either expressly or under principles of inherency, in the reference. Hinckley fails to disclose each element of the claimed invention. For example, Hinckley fails to disclose automatically registering each active element of software in a registry, as required by independent claims 1 and 6 and their respective dependents. Hinckley does not teach anything that would even lead one of ordinary skill in the art to provide automatic registration of a software element. Instead, Hinckley teaches automating testing based on a user-defined test specification. This is a much more onerous task.

During examination, claim limitations are afforded their broadest reasonable interpretation. However, even construing the claim limitations of automatically registering each active element of software in a registry in light of its broadest and reasonable interpretation, Hinckley fails to teach or suggest the above noted claim limitations.

The sentence bridging pages 3 and 4 of the final Office Action alleges that “The claimed elements registering, active element of software, and registry will not be read into the claims but will be broadly and reasonably interpreted as configuring, elements 212A-E of the software program (Figure 2) and storage area of test specifications, functions and histories of the test automation system 102, respectively (Figure 2).” Applicant disagrees with this allegation.

The term “registering” ordinarily means to record or register in a storage location. The term “active element of software” ordinarily means a software element that is active/running, particularly given that the claim is directed to a method of testing an operational integrated software system. Moreover, it is clear that the term “active element” is distinguished from other “software elements” in the claim. This is also supported at, for example, page 3, lines 19-26 of the originally-filed specification.

As noted above, the final Office Action apparently alleges that the claimed “registering” is disclosed by Hinckley’s teaching of “configuring.” Col. 7, lines 6-58 of Hinckley discloses, *inter alia*, “multiple test functions 202, each configured to test one of the discrete components 212 of the software program.” Accordingly, what is being configured is the multiple test functions 202, and not the discrete components 212. Accordingly, Hinckley fails to disclose automatically registering each active element of

software in a registry since Hinckley's disclosure relating to configuring relates to test functions 202, and not to software program components 212 (which are alleged by the Office Action to disclose the active elements of software).

Moreover, "configuring" ordinarily means to arrange with a view to a specific application or use. However, this meaning is not the same ordinary meaning as "registering." Even further, the ordinary meaning of "configuring" clearly does not disclose "automatic registering" as explicitly recited in the claims. Indeed, the Office Action fails to even address "automatic registering."

More specifically, Hinckley (see, e.g., the abstract) describes a test automation system for performing functional tests of a software program in which the test system includes a plurality of test functions, each configured to test a discrete component of the software programs, and a user-defined test-specification associated with the program and arranged to provide state definitions which specify a desired test approach for each type of test procedure to be performed on the program. All test-specific and software program-specific data are located in the user-defined test functions.

Col. 6, lines 47-49 of Hinckley states, *inter alia*, "As noted, the user, by means of user interface 209, specifies the type of test that is to be performed by the test automation system 102," and thus echoes the teachings of Hinckley's abstract. In contrast, the present invention requires elements to be registered in a register which automatically associates registered elements with an associated test. The present invention provides an automatic test specification rather than requiring a user to define a test specification for each element. Hinckley does not disclose or even suggest the automatic registering of "active elements" of software.

As noted above, the final Office Action alleges that the claimed term “active element” is disclosed by elements 212A-E of the storage program. However, there is no disclosure of any of elements 212A-E being “active”, as distinguished from other “software elements” of the claim.

Hinckley thus fails to disclose or suggest “automatically registering” (i.e., automatically recording in a memory location) each active element (i.e., each software element that is active/running) in a registry. Active elements are registered in a register which associates registered elements with an associated task. This provides an automatic test specification rather than requiring a user to define a test specification for each element, as is the case for Hinckley. (See the discussion above). Since active elements are registered and tested, the software can be continually tested in its intended operational environment. Hinckley fails to appreciate this benefit.

Accordingly, Applicant respectfully submits that claims 1-13 are not anticipated by Hinckley and respectfully requests that the rejection of these claims under 35 U.S.C. §102 be withdrawn.

**WARD et al.**

**Application No. 09/936,175**

**October 19, 2005**

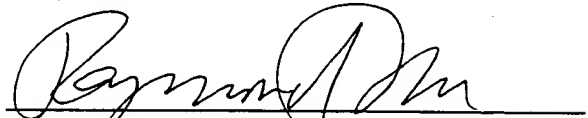
**Conclusion:**

Applicant believes that this entire application is in condition for allowance and respectfully requests a notice to this effect. If the Examiner has any questions or believes that an interview would further prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:

A handwritten signature in dark ink, appearing to read 'Raymond Y. Mah', is written over a horizontal line.

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